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Attorneys for GOOGLE LLC

13 UNITED STATES DISTRICT COURT
14
15 NORTHERN DISTRICT OF CALIFORNIA
16
17 SAN FRANCISCO DIVISION

18 SONOS, INC.,

19 Plaintiff and Counter-
Defendant,

20 vs.

21 GOOGLE LLC,

22 Defendant and Counter-
23 Claimant.

Case No. 3:20-cv-06754-WHA
Consolidated with Case No. 3:21-cv-07559-
WHA

**GOOGLE LLC'S RESPONSE TO
SONOS'S RESPONSE TO THE
COURT'S REQUESTS FOR FURTHER
BRIEFING CONCERNING WRITTEN
DESCRIPTION, INJUNCTIVE RELIEF,
AND AFFIRMATIVE DEFENSES**

Location: Courtroom 12, 19th Floor
Judge: Hon. William Alsup

Google hereby submits its response to Sonos’s brief on its “proposed course of action concerning: (i) the question of written description for overlapping zone scenes and (ii) ‘hearing and ruling on injunctive relief and the affirmative defenses.’” Dkt. 786 (quoting Dkts. 771, 775).

I. COURSE OF ACTION FOR WRITTEN DESCRIPTION AND RELATED ISSUES

A. The Circumstances Warrant Reopening The Court’s Written Description Ruling

As explained in Google’s submission, it was not until Sonos filed its reply brief during the patent showdown proceedings that Google became aware of Sonos’s reliance on the “ALL the zones” sentence pulled from its provisional patent application (the “New Matter”) as purportedly providing the key written description support for overlapping zone scenes. Dkt. 785 at 1-3. Indeed, Google had specifically asked Sonos in an interrogatory to identify any portions of its provisional application that “provide[d] support and/or written description” for the asserted claims, yet Sonos *never* identified the New Matter copied from its provisional application into the specifications of the asserted patents by amendment in August 2019. *Id.* at 2. And it was not until Mr. Lambourne’s trial testimony and the Court’s request that the parties investigate the written description issues more closely that Google uncovered and recognized the significance of the irregularities in the prosecution history of the asserted patents—specifically, that the New Matter had been added to the specifications of the asserted patents based on a section of the provisional patent application that disclosed zone grouping and *not* zone scenes. *Id.* at 3-5. Thus, even if Google could have raised these issues earlier, that is no bar to reconsideration now by the Court because it was *Sonos’s* repeated misrepresentation and failure to present complete facts regarding its alleged written description support that delayed the discovery of the underlying issue and its import. *Id.*

Contrary to Sonos’s briefing, it was *not* “entirely proper” for Sonos to rely on the “ALL the zones” sentence as providing written description because that sentence was new matter improperly added to the asserted patents by amendment, which Sonos’s trial counsel at LS3 (the firm that prosecuted these patents and others in the same family) knew, or should have known, yet failed to disclose. An applicant *may not add new matter* to an application and retain its original priority date. *See, e.g., TurboCare Div. of Demag Delaval Turbomachinery Corp. v. GE*, 264 F.3d 1111, 1118 (Fed. Cir. 2001) (“When the applicant adds a claim or otherwise amends his specification after

1 the original filing date, as [patentee] did in this case, the new claims or other added material must
 2 find support in the original specification.”); *Schering Corp. v. Amgen Inc.*, 222 F.3d 1347, 1352
 3 (Fed. Cir. 2000) (“The fundamental inquiry is whether the material added by amendment was
 4 inherently contained in the original application.”); *Litton Sys., Inc. v. Whirlpool Corp.*, 728 F.2d
 5 1423, 1437-38 (Fed. Cir. 1984). In *TurboCare*, for example, the Federal Circuit found the patentee’s
 6 original specification did not clearly or necessarily disclose the embodiment at issue and, thus, later-
 7 added claims directed to such an embodiment were invalid. 264 F.3d at 1119-20 (explaining such
 8 an embodiment “may have been obvious from [patentee’s] vague [disclosures]” but “**that is not**
 9 **enough** to satisfy the written description requirement”) (all emphases added). Indeed, the Federal
 10 Circuit upheld the district court’s finding that the claim was invalid because the patent had not been
 11 filed as a continuation-in-part (“CIP”) and, as such, the patentee could not rely on any alternative
 12 filing date for the invalidated claim. *Id.* at 1120. Similarly, in *Litton*, the Federal Circuit noted “any
 13 new matter must be added to a C-I-P application **prior to filing**, and **not** through amendment” and,
 14 thus, a patentee adding “**new matter** to a [] continuation application” would “mak[e] that application
 15 **invalid** under § 112.” 728 F.2d at 1437-38 (citing MPEP § 608.04(b)).

16 *Maquet Cardiovascular LLC v. Abiomed, Inc.*, No. CV 17-12311-FDS, 2022 WL 4138711
 17 (D. Mass. Sept. 12, 2022), cited by Sonos, is inapposite. The patent at issue there incorporated an
 18 earlier, abandoned application by reference but was later amended to “physically incorporat[e] the
 19 [earlier] application into the specification rather than incorporating it by reference.” *Id.* at *3, *7.
 20 The defendant argued that the incorporation of an unpublished, abandoned application by reference
 21 was insufficient to maintain the priority chain. The court gave “an especially weighty presumption
 22 of correctness” to the fact that the PTO had accepted incorporation by reference of the abandoned
 23 application as sufficient for maintaining priority; the court also found that physical duplication of
 24 **the entirety** of an application previously incorporated by reference did not add new matter. *Id.* at
 25 *7. Critically, the court gave the PTO the “presumption of correctness” only by “[a]ssuming that
 26 the examiner was not misled.” *Id.* By contrast, here, Sonos did not duplicate the entirety of its
 27 provisional patent Appendix A into the specifications of the asserted patents. Rather, it misleadingly
 28 plucked its New Matter sentence relating to dynamic zone grouping and dropped it into a portion of

1 the specifications describing zone scenes, thereby deviating materially from the provisional
 2 application. Sonos's amendment thus introduced new matter, and no presumption of correctness
 3 applies. It is also highly likely that the examiner was misled by Sonos's amendment.¹

4 Sonos next argues that *another* portion of the first non-provisional application provided
 5 support for overlapping zone scenes. Dkt. 786 at 3-4. Yet Sonos ***did not identify*** that passage in its
 6 summary judgment briefing or its discovery responses on written description support in the non-
 7 provisional applications—for good reason, because the cited passage actually proves Google's
 8 point. The statement in the non-provisional application that “a controlling device (also referred to
 9 herein as controller) is provided to facilitate a user to select any of the players in the system to form
 10 ***respective groups each of which is set up per a scene***” teaches the opposite of overlapping zone
 11 scenes. It explains that any of the zone players can be chosen to join a “respective group” (*i.e.*, a
 12 separate group) and that ***each*** such group may
 13 be set up as part of ***a particular scene***, not
 14 multiple overlapping zone scenes as claimed
 15 in the asserted patents. For example, annotated
 16 Fig. 3B (to the right) shows that certain players
 17 have been grouped into two respective groups
 18 (Group 1 and Group 2) and that each group is
 19 set up as part of the same “Evening Scene” as
 20 described at col. 9, lines 1-15 of the '885 Patent.

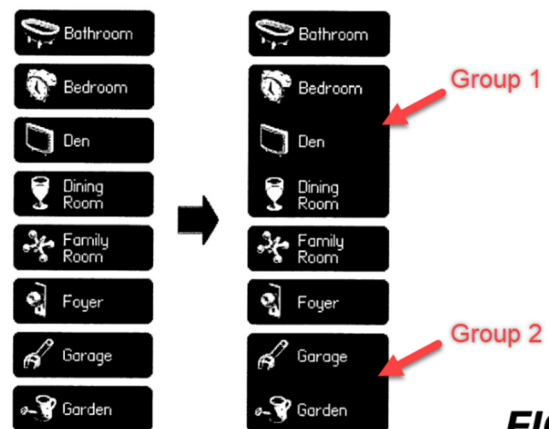


FIG. 3B

21 In no way does this disclosure teach those of ordinary skill in the art that any of the players
 22 may be joined to ***multiple*** zone scenes let alone multiple ***overlapping*** scenes. *See* Dkt. 729 at 3-4

23
 24 ¹ Dr. Schonfeld's recitation of the prosecution history in his expert report does not suggest that
 25 Google was aware of Sonos's prosecution irregularities before trial. Dkt. 786 at 2-3. Dr. Schonfeld
 26 merely noted that an amendment to the specification had added the “ALL the zones” sentence. *Id.*
 27 The simple fact that there was an amendment is not the basis for Google's request for
 28 reconsideration. Rather, Google's request is based on recent discovery that the sentence was pulled
 from a portion of the provisional application relating to dynamic zone grouping, which the
 inventor's trial testimony made clear is ***not*** zone scenes, as well as other irregularities in the
 provisional application (*i.e.*, that key information regarding “party mode” in the Sonos 2005 prior
 art system had been scrubbed from the appendices). Dkt. 785 at 3-6.

1 (explaining why this statement discloses **non-overlapping** zone scenes); *id.* at 3-9 (explaining other
2 disclosures in the same application also teach non-overlapping zone scenes). And the fact that this
3 statement was made in the context of “the present invention” means that, prior to 2019, Sonos itself
4 did **not** consider the alleged invention to include overlapping zone scenes. *See, e.g., Verizon Servs.*
5 *Corp. v. Vonage Holdings Corp.*, 503 F.3d 1295, 1308 (Fed. Cir. 2007) (holding that statements in
6 specification concerning “the” invention limited the scope of the claims). Because the New Matter
7 sentence was not added to the nonprovisional application (which itself requires an inference as
8 conceded by Sonos’s counsel in response to the Court’s questioning during trial), Sonos again tries
9 to **infer** a disclosure of overlapping zone scenes where there is none. This type of inference is
10 inadequate as a matter of law. *See, e.g., Crown Operations Int’l, Ltd. v. Solutia Inc.*, 289 F.3d 1367,
11 1380 (Fed. Cir. 2002) (explaining “the novel aspects of the invention must be disclosed and not left
12 to inference, that is, a patentee may not rely on the inference of a person of ordinary skill in the
13 pertinent art to supply such novel aspects”). “Working backward from a knowledge of [the claims]”
14 to “derive written description support from an amalgam of disclosures plucked selectively from the
15 [disclosures]” is inadequate to satisfy the written description requirement. *Novozymes v. DuPont*
16 *Nutrition Biosciences APS*, 723 F.3d 1336, 1349 (Fed. Cir. 2013). The non-provisional application
17 simply did not provide any written description of overlapping zone scenes, further proving that new
18 matter was added by amendment in 2019, even assuming the New Matter sentence provided
19 adequate written description support (which it does not since it relies on an inference at best).

20 Finally, Google was not required to file a motion for reconsideration or otherwise ask the
21 Court to revisit its prior written description ruling or else risk forever acceding to its outcome. *See*
22 *Dkt. 786* at 4 (arguing that “Google **dropped** its written description defenses for both the ’885 and
23 ’966 patents”). Just as parties must accept adverse claim constructions, they must accept adverse
24 summary judgment rulings for purposes of trial, subject to their right to appeal those rulings later.
25 That does not mean that Google abandoned the defense, nor that either it or the Court is precluded
26 from revisiting the written description issue based on changed circumstances.

B. Google Raised The Written Description Issues Of Which It Was Aware, And Never Dropped Or Withdrew Its Defense

Sonos also argues that the Court should look the other way on written description because Google did not “challenge the priority date of the ’885 patent based on alleged deficiencies in the written description of earlier family members” (Dkt. 786 at 2) and did not “raise all arguments in support of its written description challenge at the time it went forward with the challenge.” *Id.* at 5. As explained in Google’s submission (and above), however, there is good cause for the Court to reconsider these issues now in view of the more complete record developed through trial. Dkt. 785 at 6-15. Tellingly, Sonos’s submission largely ignores the Court’s discretion to review its own prior order in view of the more complete trial record and recently discovered facts, and that discretion is *unaffected* by the “party-presentation rule.” “When an issue or claim is properly before the court, the court is not limited to the particular legal theories advanced by the parties, but rather retains the independent power to identify and apply the proper construction of governing law.” *Kamen v. Kemper Fin. Servs.*, 500 U.S. 90, 99 (1991) (citation omitted).²

C. No Further Fact Or Expert Discovery Is Required For The Court To Address The Written Description Issues

Because important issues, including both written description and Google’s affirmative defenses, remain undecided, Google respectfully urges the Court to vacate the judgment entered yesterday and proceed to decide those issues. In any event, contrary to Sonos’s arguments, no additional fact discovery or expert opinions are needed to find that the asserted patents lack written

² The cases cited by Sonos are inapposite. In *United States v. Sineneng-Smith*, 140 S. Ct. 1575, 1579 (2020), the Supreme Court held that the Ninth Circuit abused its discretion in finding a statute unconstitutional and overbroad based on invited briefing from three *amici* despite that the defendant “presented a contrary theory of the case in the District Court.” *Id.* at 1581. That is a far cry from a trial court reconsidering its own prior order on written description. Dkt. 785 at 6-15. Indeed, the Court in *Sineneng-Smith* recognized that “[t]he party presentation principle is supple, not ironclad. There are no doubt circumstances in which a modest initiating role for a court is appropriate.” *Id.* at 1579 (citing *Day v. McDonough*, 547 U. S. 198, 202 (2006) (finding court had “authority, on its own initiative,” to correct a party’s “evident miscalculation of the elapsed time under a statute” absent “intelligent waiver”). For its part, *AMA Multimedia, Ltd. Liab. Co. v. Wanat* merely held that “[a]bsent exceptional circumstances, we generally will not consider arguments *raised for the first time on appeal*” (despite recognizing it “[had] discretion to do so”). 970 F.3d 1201, 1213 (9th Cir. 2020).

1 description support for overlapping zone scenes. There are no disputed facts regarding the timing
 2 and substance of the specification amendments. Nor do any of the five points raised by Sonos as
 3 “material facts in dispute” (Dkt. 786 at 7) require further discovery or fact findings to resolve. The
 4 facts on their face make clear that the “ALL the zones” language added to the specifications of the
 5 asserted patents in 2019 was improper new matter that appeared in the provisional application in a
 6 different context than where it was transposed into the asserted patents’ specifications.³ It is also
 7 clear on the current record that nothing else in the specifications disclosed the concept of
 8 overlapping zone scenes. *See generally*, Dkts. 712, 729, 785. Moreover, Sonos had more than a
 9 full and fair opportunity to address the written description issues through the patent showdown
 10 process (during which it failed to disclose that the New Matter had been transposed into the
 11 specifications by amendment in 2019 from a different context in the provisional application) and in
 12 numerous subsequent trial briefs and oral arguments. *See D Three Enterprises, LLC v. SunModo*
 13 *Corp.*, 890 F.3d 1042, 1048-49 (Fed. Cir. 2018) (district court did not err in granting summary
 14 judgment based on an inadequate written description despite no such argument by defendant because
 15 the patentee “knew” that lack of written description “would be an issue” and “had a full opportunity
 16 to present evidence to support [its] position”) (internal quotations omitted).

17 Sonos further argues that “Rule 60 is also not a proper vehicle for reopening written
 18 description or considering new arguments about how written description impacts the patents’
 19 priority date” (Dkt. 786 at 7-8), yet it nowhere addresses Rule 60(b). Rather, Sonos characterizes
 20 any reconsideration of the written description issues as being a “deviat[ion] from the original intent
 21 of the [C]ourt” akin to the Court “chang[ing] its mind,” which Sonos argues is improper under **Rule**
 22 **60(a)**. *Id.* But Rule 60(b) permits the Court to reconsider the written description issue to correct
 23 any misrepresentation (or misconduct by an opposing party) or for any other reason that justifies
 24

25 _____
 26 ³ Sonos argues that “Google still has not yet laid out clear factual and legal arguments as to why
 27 the addition of the ‘ALL the zones’ sentence either (i) cannot be considered in evaluating written
 28 description of the ’885 and ’966 patents or (ii) constitutes the addition of new matter that would
 break the priority chain.” Dkt. 786 at 6. Yet Google filed multiple trial briefs on this issue. *See*,
e.g., Dkt. 729 at 9-12 (explaining “ALL the zones” is new matter); Dkt. 712 at 1-2 (citing cases for
 why the amendment invalidates); Dkt. 722 (answering the Court’s questions regarding the same).

1 relief, consistent with the reasons to do so set forth in Google’s submission. Dkt. 785; Fed. R. Civ.
 2 P. 60(b). Whether to grant relief under Rule 60(b) is committed to the Court’s sound discretion. *In*
 3 *re Int’l Fibercom, Inc.*, 503 F.3d 933, 939, 941 (9th Cir. 2007). The Court is also entitled to vacate
 4 the recently issued judgment under Rule 59(d) and use its inherent authority to reconsider its rulings.

5 **D. No Additional, Let Alone “Significant,” Resources Would Be Required For the**
 6 **Court To Reconsider And Address The Written Description Issues**

7 As discussed *supra*, the Court need not reopen fact or expert discovery to decide these issues.
 8 Sonos contends that it would need to serve new written discovery, but Sonos is already in possession
 9 of any additional facts it may want to elicit at least because its trial counsel prosecuted the asserted
 10 patents and also knew written description was at issue early in this case. There is also no need for
 11 written discovery on Google for Sonos to understand Google’s priority date challenge. Google’s
 12 position is clear from the briefing and trial arguments on this issue. *E.g.*, Dkts. 712, 722, 729.
 13 Google’s position is simple: addition of the New Matter to the asserted patents’ specifications in
 14 August 2019 was improper, and the patents are invalid for lack of written description as a result.
 15 Alternatively, if the Court holds that the introduction of the New Matter was proper but changes
 16 Sonos’s effective filing date to 2019, then the claims are invalid under the on-sale bar of pre-AIA
 17 Section 102(b) because Sonos has asserted them against Google products released four years earlier.
 18 No significant additional resources will be required for the Court to reconsider and address the
 19 written description issues. Nor would a second jury trial be required. Dkt. 786 at 10. The Federal
 20 Circuit has often held that “[c]ompliance with the written description requirement [of 35 U.S.C. §
 21 112(a)] is a question of fact **but is amenable to summary judgment in cases where no reasonable**
 22 **fact finder could return a verdict for the non-moving party.**” *D Three Enterprises*, 890 F.3d at
 23 1047 (emphasis added); *PowerOasis, Inc. v. T-Mobile USA, Inc.*, 522 F.3d 1299, 1307 (Fed. Cir.
 24 2008). Such is the case here, where the Court already was able to rule once on the written description
 25 issue on summary judgment—without any objection from Sonos. Dkt. 309.

26 Sonos’s proposed discovery schedule is a bluff intended to discourage immediate resolution
 27 of the written description issue. Indeed, it is unclear why Sonos would need to “serve subpoenas”
 28 or reopen invalidity contentions such that Google must serve “supplemental invalidity disclosures”

1 that are “to the same level of detail required by the local rules” in order for the Court to decide one
 2 isolated written description issue. There is no need for additional discovery.

3 **II. COURSE OF ACTION FOR INJUNCTIVE RELIEF, DAMAGES, AND** 4 **AFFIRMATIVE DEFENSES**

5 On the one hand, Sonos cites the parties’ upcoming ITC trials in June and July 2023 to
 6 propose a schedule for further discovery on the written description issues that puts “about three
 7 months’ time between now and the start of expert discovery.” Dkt. 786 at 10. Yet in the same breath,
 8 Sonos seeks accelerated briefing on injunctive relief and damages issues that could (and should) be
 9 moot in view of the written description issues, the parties’ Rule 50(b) motions, and Google’s
 10 remaining affirmative defenses (*see infra*). There is no reason for the parties to engage in discovery
 11 and briefing on damages issues that are likely to be mooted or at least significantly affected by the
 12 many open issues in this case. Sonos’s proposal for production of updated damages information
 13 and briefing should be denied without prejudice pending resolution of other, predicate issues.
 14 Sonos’s injection of damages-related issues such as ongoing royalties, supplemental damages and
 15 pre- and post-judgment interest into its submission should be disregarded as unresponsive to the
 16 Court’s request for additional briefing on a “proposed course of action for hearing and ruling on
 17 injunctive relief and the affirmative defenses.” Dkt. 775. Google will respond fully to Sonos’s
 18 arguments if and when they are properly brought before the Court. Nevertheless, Google responds
 19 briefly to Sonos’s assertions.

20 ***Injunction.*** As Google noted in its submission, Sonos is not entitled to any injunctive relief
 21 under the facts of this case because it has not demonstrated any irreparable injury not compensable
 22 by monetary damages. *eBay Inc. v. MercExchange, L.L.C.*, 547 U.S. 388, 391 (2006); *Nichia Corp.*
 23 *v. Everlight Americas, Inc.*, 855 F.3d 1328, 1344 (Fed. Cir. 2017) (affirming denial of injunctive
 24 relief where patentee failed to establish irreparable harm). Sonos’s new request for an injunction
 25 with respect to “*indirect* infringement” of the ’885 Patent “going forward” also lacks merit. Dkt.
 26 768 at 11 (emphasis in original). Sonos appears to contend that the jury’s finding of ***direct***
 27 infringement of the ’885 Patent can now establish the notice and specific intent requirements for
 28 ***indirect*** infringement. But the Court already granted Google’s motion for summary judgment of no

1 indirect infringement for the '885 patent. Dkt. 566 at 29-31. And the only indirect infringement
 2 claim Sonos presented at trial was for the '966 Patent, which the jury found Google did not infringe.
 3 Dkt. 774 at 2-3; Dkt. 762 at 17 (“Sonos accuses Google of indirectly infringing the '966 patent.”).
 4 Sonos *never proffered* any theory or evidence of indirect infringement at trial for the '885 Patent.
 5 *See, e.g.*, Dkt. 615 at 3 (“For purposes of this trial, Sonos seeks a judgment (1) . . . that Google’s
 6 newer products *directly infringe* claim 1 of the '885 patent”) (emphasis added). Sonos cannot now
 7 seek an injunction for a claim that was never presented nor adjudicated by the jury. *CH2O, Inc. v.*
 8 *Meras Eng’g, Inc.*, 2017 WL 1700844, at *4 (C.D. Cal. May 2, 2017) (rejecting proposed injunction
 9 precluding “actions that induce or contribute to infringement” when the jury only “concluded that
 10 Defendants directly infringed” because “[t]he injunctive relief will be limited to barring the activities
 11 that were presented at trial as to which the verdict was entered”). Indeed, it is unclear what indirect
 12 infringement Sonos is even attempting to enjoin with respect to the '885 Patent.

13 ***Ongoing Royalty Rate.*** Google maintains that the \$2.30 royalty rate awarded by the jury is
 14 unsupported by any evidence in the trial record and will address this issue via proper motion
 15 practice, including in its Rule 50(b) motion. The only evidence the jury could have utilized was
 16 Sonos’s non-comparable, portfolio-wide settlement agreements, which were unreliable and could
 17 not form the basis for any damages award as presented by Sonos. *See* Dkt. 756 at 32-33. Sonos
 18 provided no way for the jury to apportion those agreements to the specific invention. *Id.*; *Finjan,*
 19 *Inc. v. Blue Coat Sys., Inc.*, 879 F.3d 1299, 1311-12 (Fed. Cir. 2018) (holding that “Finjan failed to
 20 present a damages case that can support the jury’s verdict” because “[t]here is no evidence that
 21 Finjan ever actually used or proposed an \$8-per-user fee in any comparable license or negotiation”
 22 such that the trier of fact had no “factual basis for a determination of a reasonable royalty”). And
 23 for the reasons discussed above, Sonos’s request for royalties for purported “indirect infringement”
 24 of the '885 Patent (a claim that the jury never heard nor found) should be denied.⁴

25
 26
 27 ⁴ *See, e.g., Opticurrent, LLC v. Power Integrations, Inc.*, 2019 WL 2389150, at *4-7 (N.D. Cal. June
 28 5, 2019), *aff’d*, 815 F. App’x 547 (Fed. Cir. 2020) (reducing royalty base from sales of accused
 products that directly and indirectly infringed to sales of accused products that only directly
 infringed where “[t]he jury found no inducement”).

1 **Supplemental Damages.** Sonos’s request for “supplemental damages” based on Google’s
 2 redesign is nonsensical. Based on the jury’s verdict that Google’s alleged redesign was still
 3 infringing, Sonos argues it should be entitled to additional damages for speakers sold prior to the
 4 damages period but that “received the infringing software update” because at that point Google
 5 apparently “made” those infringing devices anew. Dkt. 786 at 14-15. But Sonos does not provide
 6 any authority for the notion that updating a product that Google had already sold prior to the
 7 damages period somehow constitutes “mak[ing]” a new patented invention under 35 U.S.C. §
 8 271(a).⁵ Nor could it. These devices received software updates before the redesign, and Sonos
 9 never previously argued that such updates constitute a new act of infringement, nor did it accuse
 10 any additional products that had been sold outside the damages period on this basis.⁶

11 **Prejudgment and Post-Judgment Interest.** To the extent Sonos is ultimately awarded any
 12 damages, Google will address Sonos’s requests for interest at the appropriate time. *See, e.g., Bio-*
 13 *Rad Laboratories, Inc. v. Nicolet Instrument Corp.*, 807 F.2d 964, 969 (Fed. Cir. 1986).

14 **Affirmative Defenses.** Google has identified several affirmative defenses that remain for
 15 the Court’s determination. *See* Dkt. 785 at 15. To the extent any of these equitable defenses require
 16 any underlying facts, those facts have already been adduced as part of the discovery and trial record.
 17 Accordingly, Google is entitled to resolution of its remaining affirmative defenses.

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 23 ⁵ The cases Sonos cites are inapposite. *Centrak, Inc. v. Sonitor Techs., Inc.*, 915 F.3d 1360 (Fed.
 24 Cir. 2019), merely held that there were genuine disputes of fact as to whether a party that completes
 25 the “software setup necessary to make the system work” can infringe when it does not make all the
 26 components needed for infringement. Here, providing firmware updates is not “assembling
 components into the claimed assembly.” *Id.* at 1364. And *Lifetime Indus., Inc. v. Trim-Lok, Inc.*,
 869 F.3d 1372 (Fed. Cir. 2017), is not about software at all. And neither case involves products
 sold before the damages period.

27 ⁶ Indeed, setting such a precedent would disincentivize an accused infringer from pursuing
 28 redesigns. *See TiVo Inc. v. Echostar Corp.*, 646 F.3d 869, 883 (Fed. Cir. 2011) (“[L]egitimate
 design-around efforts should always be encouraged as a path to spur further innovation.”).

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CERTIFICATE OF SERVICE

The undersigned certifies that on May 31, 2023, all counsel of record who are deemed to have consented to electronic service are being served with a copy of this document through the Court's CM/ECF system.

DATED: May 31, 2023

/s/ Sean Pak

Sean Pak